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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,189	10/25/2004	Gang Wu	4035-0167PUS1	9210

2292 7590 01/11/2006

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EXAMINER	
APPIAH, CHARLES NANA	
ART UNIT	**PAPER NUMBER**
2686	

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/500,189	WU ET AL.	
	Examiner	Art Unit	
	Charles N. Appiah	2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 October 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,12 and 14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,12 and 14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *6/25/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on December 19, 2005 have been fully considered but they are not persuasive. In regard to applicant's argument that "the present invention differs from the Silver et al., device by relying on a communication system which does not have a calling function such as a LAN system". "Thus, independent claims 1, 3, 7 and 9 all now describe one of the systems as being a non-calling system", examiner maintains that the paging system of system of Silver meets "the non-calling system" limitation of Applicant's invention as claimed since the paging system clearly is a data system having no calling function.

Additionally, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "in the present invention, a data system having no calling function is connected with a pager system") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Applicant's argument that Fujimori et al., does not teach "two wireless communication systems one of which provides for wireless calling with the other having no calling function", examiner maintains that Fujimori's pager meets the non-calling terminal of the instant invention.

In view of the above the rejections using Silver and Fujimori are maintained as repeated below. These rejections are made FINAL.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by **Silver et al. (5,701,337)**.

Regarding claim 1, Silver discloses a wireless communication method (see Fig. 7), for performing wireless communication between a calling side and a called side, the wireless communication method using a wide-area wireless communication system capable of wireless calling (cellular network 43), and a non-calling wireless communication system capable of data communication (paging network 49), the method comprising: a call sending step of sending a call to the called side by the calling side (inherent feature of receiving incoming call at cellular network, step 81, col. 6, lines 48-49), a calling step of using the wide-area wireless communication system to call receiving means in a wireless communication terminal of the called side (transmit mobile paging signal to mobile phone portion, steps 83, 85, 89, 91, col. 6, lines 50-53), a calling detecting step of detecting, by the wireless communication terminal, calling from the wide-area wireless communication system (pager portion (pager portion

receiving paging signal, step 93, col. 6, lines 53-57), a calling notifying step of notifying, by the receiving means in the wireless communication terminal, wireless communication controlling wireless communication means that the receiving means has been called, (pager portion activates mobile phone portion, step 95, col. 7, lines 1-8), a connecting step of connecting to the wireless communication system by the wireless communication means (mobile phone portion registers with cellular network, step 97, col. 7, lines 9-10), a communicating step of performing wireless communication between the calling side and the called side (cellular phone routing call inherently between calling terminal and the called terminal, step 99, col. 7, lines 10-12), and a disconnecting step of disconnecting connection to the wide area wireless communication system by at least one of the calling side and the called side (turning off mobile phone portion after completion of each call, step 101, col. 7, lines 7-12).

Regarding claim 2/1, Silver further discloses wherein, in the communication step, a speech conversation is performed (routing of call to the mobile portion in the normal manner inherently leads to performance of speech conversation, see col. 7, lines 10-12).

Regarding claim 3, Silver discloses a wireless communication system (see Figs. 6-7), capable of data communication, comprising: a calling terminal for a calling side to perform communication (incoming call received at cellular network is made by calling terminal, step 81), a network to which the calling terminal is connected (cellular network 43), a wireless communication base station (inherent in cellular network, 43), and a wide area wireless communication base station which are connected to the

network (inherent in paging network, 49), and a wireless communication terminal for a called side to perform communication (combined mobile phone/pager 1), wherein the wireless communication terminal is a non-calling wireless communication terminal (combined mobile phone/pager 1), simultaneously comprises receiving means for receiving a call from the wide-area wireless communication base station (feature of receipt of paging signal 51, col. 6, lines 34-36), and communication means for performing data communication with the wireless communication base station (call being routed to terminal 1 from cellular network).

Regarding claim 9, Silver discloses a wireless communication terminal (1), capable of communicating with both a wide area wireless communication system capable of wireless calling (paging network 49), and a wireless communication system capable of data communication (cellular network 43), the wireless communication terminal comprising: receiving means for receiving a wireless call in the wide area wireless communication system (page 510, calling information recognizing means for recognizing information concerning a calling side and calling details, the information being included in the wireless call (see col. 6, line 61 to col. 7, line 8), and wireless communication means for performing wireless communication in the wireless communication system when the calling information recognizing means requests wireless communication to start (see col. 7, lines 1-16).

Regarding claim 10, Silver further discloses wireless communication means activating means (pager portion activates mobile phone portion, see col. 7, lines 1-10), in a configuration in which the wireless communication means in the wireless

communication terminal is normally in an inactivated state when the calling information requests wireless communication to start, the wireless communication means activating means changes the wireless communication means to be activated (see col. 7, lines 1-16).

3. Claims 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by **Fujimori et al. (6,327,475).**

Regarding claim 7, Fujimori discloses a wide-area wireless communication base station for a wide area wireless communication system (see Fig. 6) in which a calling side is capable of calling a called side, the base station comprising a plurality of means: network connecting means for connecting to a network which is not for the wide area wireless communication (see connection to telephone line), calling-request receiving means for receiving a calling request using an identification number on the network for a non-calling wireless terminal of the called side (receiving section 11 receives telephone numbers and a message, col. 7, lines 43-46), intersystem identification number converting means for converting an identification number on the network to an identification number in the wide area wireless communication system (conversion section converts the telephone number into paging signal, col. 7, lines 46-52), and a calling means for calling the wireless communication terminal by using an identification number in the wide area wireless communication system, (transmission of paging signal and the message by radio, see col. 7, lines 50-52, col. 8, lines 11-35).

Regarding claim 8, Fujimori further discloses wherein the wide area communication system is a pager system (paging system, col. 8, lines 21-42).

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Silver et al** as applied to claims above, and further in view of **Tran (6,496,693).**

Regarding claims 4 and 11, Silver further discloses as illustrated in Fig. 1, audio input/output means for outputting the audio obtained by conversion and inputting of audio (see microphone/speaker which is standard to mobile phone/pager 1), but fails to explicitly teach audio and/or audio/data conversion means for performing mutual conversion between audio information and data information.

In an analogous field of endeavor, Tran discloses a method for transmitting data and/or audio messages through transforming a voice message into a text message and using speech recognition (see col. 1, line 55 to col. 2, line 2, col. 4, lines 20-41).

It would therefore have been obvious to one of ordinary skill in the art to incorporate Tran's text to speech and speech to text technology into Silver's mobile phone /pager terminal in order to facilitate the capability of receiving messages in different formats such as text or voice.

6. Claims 5/3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Silver et al.** as applied to claim 3 above, and further in view of **Blink et al. (6,542,751).**

Regarding claims 5/3 and 12, Silver further discloses wherein the wide area wireless communication base station is a pager base station (inherent in paging network 49) and the wireless terminal includes receiving means corresponding to the pager base station (page 51 reception capability), but fails to specifically disclose that the wireless communication system is a wireless LAN, WAN, PAN, or ITS system.

Blink discloses a multi-mode paging system that can selectively page an individual through a plurality of paging mechanisms (see col. 1, line 54 to col. 2, line 3). According to Blink, the processor-based paging unit can be used in a Local Area Network (LAN), wide area pager (see Fig. 1, col. 2, line 46 to col. 3, line 8).

It would therefore have been obvious to one of ordinary skill in the art to use Silver's combined mobile phone/pager as a multi-mode terminal capable of communicating in different systems such as a LAN in order to provide greater flexibility and roaming capabilities as taught by Blink.

7. Claim 5/4 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Silver et al and Tran** as applied to claim 4 above, and further in view of **Blink et al. (6,542,751).**

Regarding claim 5/4, Silver further discloses wherein the wide area wireless communication base station is a pager base station (inherent in paging network 49) and the wireless terminal includes receiving means corresponding to the pager base station (page 51 reception capability), but the combination of Silver and Tran fail to specifically disclose that the wireless communication system is a wireless LAN, WAN, PAN, or ITS system.

Blink discloses a multi-mode paging system that can selectively page an individual through a plurality of paging mechanisms (see col. 1, line 54 to col. 2, line 3). According to Blink, the processor-based paging unit can be used in a Local Area Network (LAN), wide area pager (see Fig. 1, col. 2, line 46 to col. 3, line 8).

It would therefore have been obvious to one of ordinary skill in the art to use Silver's combined mobile phone/pager as further modified by Tran as a multi-mode terminal capable of communicating in different systems such as a LAN in order to provide greater flexibility and roaming capabilities as taught by Blink.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Foladare et al. (5,742,906) discloses a personal reach communications system for bridging a call between a calling party and a called party. Jawanda (6,243,581) discloses a system for seamless roaming between wireless communication networks.

Grimes et al. (5,463,623) disclose an integrated wireless telecommunication and local area network.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles N. Appiah whose telephone number is 571 272-7904. The examiner can normally be reached on M-F 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 571 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CA

CHARLES APPIAH
PRIMARY EXAMINER